



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/824,752

04/15/2004

B. Thomas Barker

4002-1675/PC345.00

7045

7590 07/17/2007
Woodard, Emhardt, Moriarty, McNett & Henry LLP
Bank One Center/Tower
Suite 3700
111 Monument Circle
Indianapolis, IN 46204-5137

EXAMINER

ARAJ, MICHAEL J

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

07/17/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/824,752

Applicant(s)

BARKER, B. THOMAS

Examiner

Michael J. Araj

Art Unit

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-14 is/are allowed.
- 6) ☒ Claim(s) 1-9, 15-33, 35, 36 and 38 is/are rejected.
- 7) ☒ Claim(s) 34, 37, 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/19/07
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Objections

Claim 20 is objected to because of the following informalities: It appears that in line 2 there appears to be a missing "a" between 'is' and 'threaded'. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 20, line 2, "said second channel" appears to be new matter because nowhere in the disclosure is it stated that "said aperture is a threaded bore and intersect said second channel".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Brace et al. (U.S. Patent No. 6,187,005).

Brace et al. disclose a method comprising providing a connection device (90) having a body (92) with a first channel (108), second channel (88) and a third threaded channel (28) where said body tapers outwardly towards said second end, sliding a washer (106) over (also interpreted as “above”) said body to said fastener (94) where the diameter is smaller than the diameter of the tapered portion of said body, sliding a ring-shaped offsetting member (100) slidable over (also interpreted as “above”) said first end wherein said offsetting member contacts said spinal fastener in at least two locations and a fixation member (set screw-30) is insertable in said third channel intersecting said first channel and arranged at an angle relative to a line between said first channel and said second channel (Fig 11). The offsetting member has a groove (104) and includes two different inner diameters because the hole (102) is conical. The offsetting member is slidably connected to said body member via the fixation member and can be interpreted as being between the elongated member (16) and said bone fixation member since a most central portion of the offsetting member is placed in between them. The body is placed over said elongated member via said second

Art Unit: 3733

channel and a locking member is inserted into said aperture thereby locking said fastener with respect to said elongated member.

Claims 22-24, 26-33 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Baker (U.S. Patent No. 5,947,967).

Baker discloses a body member (21) having a first channel (40) and a second channel (25); an elongated member (spinal rod (R)) at least partially within said first channel; a bone fixation member (10)(includes a threaded member, hook and clamp) at least partially within said second channel; a ring-shaped offsetting member (65) slidably connected to said body member and positioned between said elongated member and said bone fixation member; a washer (22) having a substantially radial groove (47) where said washer connected to said body so that said groove accommodates at least a portion of said bone fixation member; and a locking member (set screw) connected to said body. The offsetting member includes two different inner diameters, wherein one is defined between the most inner cylindrical edges (67) and the other defined between the just inside the outside edge of the offsetting members edges.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3,6-9,35 and 36 are rejected under 35 U.S.C. 10(a) as being unpatentable over Yoshimi et al. (U.S. Patent No. 5,5562,661) in view of Brace et al. (U.S. Patent No. 6,187,005).

Yoshimi et al. disclose a connection device having a body (14) with a first channel (34), second channel (32) where said body tapers outwardly towards said second end, a washer (50) slidably mountable over (also interpreted as "above") said body to said fastener (12) where the diameter is smaller than the diameter of the tapered portion of said body and having a groove (62), a ring-shaped offsetting member (26) slidable over (also interpreted as "above") said first end wherein said offsetting member contacts said spinal fastener in at least two locations. The offsetting member has a groove (threads) and includes two different inner diameters (apex of the thread and valley of the thread). Yoshimi et al. disclose the claimed invention except for a fixation member that is insertable in a third channel intersecting said first channel and arranged at an angle relative to a line between said first channel and said second channel. As stated above, Brace et al. disclose this fixation member in order to better fix the spinal rod (Col. 4, Paragraph 7). It would have been obvious to one skilled in the art at the time the invention was made to have created the device of Yoshimi et al. with a third channel intersecting the first channel containing a set screw to lock the elongated member and the spinal fastener in view of Brace et al., in order to have a more stable device.

Art Unit: 3733

Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimi et al. (U.S. Patent No. 5,5562,661) in view of Brace et al. (U.S. Patent No. 6,187,005), as interpreted in claim 1 above, further in view of Justis et al. (U.S. Patent No. 6,210,413).

The combination of Yoshimi et al. and Brace et al. disclose the claimed invention except for being made of shape memory material. Justis et al. discloses using a shape memory material so that the device can have different configurations under different temperatures (abstract). It would have been obvious to one skilled in the art at the time the invention was made to have created the device of Yoshimi et al. and Brace et al. with a shape memory material in view of Justis et al., in order to have a more versatile device.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (U.S. Patent No. 5,947,967) in view of Justis et al. (U.S. Patent No. 6,210,413).

The Baker discloses the claimed invention except for being made of shape memory material. Justis et al. discloses using a shape memory material so that the device can have different configurations under different temperatures (abstract). It would have been obvious to one skilled in the art at the time the invention was made to have created the device of Baker with a shape memory material in view of Justis et al., in order to have a more versatile device.

Response to Arguments

Applicant's arguments with respect to claims 1-9 and 22-33 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed on April 19, 2007, with concerns to claim 15 have been fully considered but they are not persuasive. Applicant argues that neither the nut nor the ball clamp of Brace "slide over" a body. As indicated in the interpretation above, the nut slides over or "above" the body. The threads of the nut are sliding with the threads of the upper part of the fastener (98). And the ball clamp is sliding with the conical section (96) of the fastener. These sliding mechanisms are happening "above" (or on top of) the body of the device, which is equivalent to the meaning of "over" the device.

Allowable Subject Matter

Claims 10-14 are allowed.

Claims 34, 37 and 39 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.

Art Unit: 3733

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

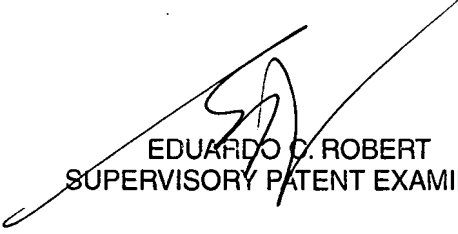
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Araj whose telephone number is 571-272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3733

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MJA


EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER